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MAILED
FEB 10 2006
TECHNOLOGY CENTER 2100

In re Application of: Yates Jr., et al.
Application No. 09/385,394
Filed: August 30, 1999
For: COMPUTER WITH TWO EXECUTION
MODES

**REQUEST FOR EXTENSION
OF TIME under 37 CFR §
1.136(b)**

This is a decision on the petition filed on December 1, 2005, requesting an extension of time under 37 CFR § 1.136 (b).

The Petition has been **DISMISSED** as moot.

Petitioner provided a statement that the extension of time under 37 CFR 1.136(b) should be granted because the PTO, through failure to observe written procedures and binding law with respect to the final rejection of October 25, 2004, and through no fault of Applicant, is necessary in order to seek further review within the PTO and to allow submission of an Appeal Brief.

37 CFR § 1.136(b) states:

(b) *When a reply cannot be filed within the time period set for such reply and the provisions of paragraph (a) of this section are not available*, the period for reply will be extended *only for sufficient cause* and for a reasonable time specified. Any request for an extension of time under this paragraph must be filed *on or before the day on which such reply is due*, but the mere filing of such a request will not affect any extension under this paragraph. In no situation can any extension carry the date on which reply is due beyond the maximum time period set by statute. See § 1.304 for extensions of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action; § 1.550(c) for extensions of time in ex parte reexamination proceedings; § 1.956 for extensions of time in inter partes reexamination proceedings; and §§ 41.4(a) and 41.121(a)(3) of this title for extensions of time in contested cases before the Board of Patent Appeals and Interferences. Any request under this section must be accompanied by the petition fee set forth in § 1.17(g). [emphasis added]

MPEP 1205.01 Time for Filing Appeal Brief set forth:

37 CFR § 41.37(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief and the appeal brief fee set forth in 37 CFR 41.20(b)(2).

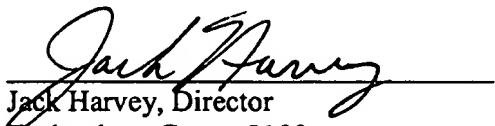
This 2-month time period for a patent application may be extended under 37 CFR 1.136(a), *and if 37 CFR 1.136(a) is not available*, under 37 CFR 1.136(b) for extraordinary circumstances. [emphasis added]

A review of the file record indicates that a Notice of Appeal was filed on April 28, 2005 and corresponding Appeal Brief was received on December 1, 2005, with a certificate of mailing under 37 CFR § 1.8 on November 28, 2005 (same day as seven month expiration date from the filing of the Notice of Appeal). As set forth, 37 CFR § 1.136(b) only becomes available when 37 CFR 1.136(a) is no longer available.

In this instance, an Appeal Brief was filed within the time period set forth under 37 CFR § 41.37(a) and in accordance with the extensions of time available under 37 CFR § 1.136(a), as evidenced by the file record in the instant application. To maintain pendency and in order to consider the Appeal Brief as having been timely filed, the request for extension of time for five (5) months under 37 CFR 1.136(a) has been approved.

Since there is no outstanding reply due, there is no cause for an extension of time under § 1.136(b). Accordingly, the petition for extension of time under 37 CFR 1.136(b) is **DISMISSED** as moot.

The application is being forwarded to the Examiner of record for consideration of the Appeal Brief filed December 1, 2005. Note, the fee for the five (5) months extension of time under 37 CFR § 1.136(a) in the amount of \$2,160.00 was charged to Deposit Account No. 23-2405 on December 7, 2005.



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TECHNOLOGY CENTER 2100

In re Application of: Yates, et al.)
Application No. 09/385,394) DECISION ON PETITION FOR
Attorney Docket No. 114596-03-4000) SUPERVISORY REVIEW
Filed: 08/30/1999) UNDER 37 CFR §1.181
For: COMPUTER WITH TWO)
EXECUTION MODES)

This is a decision on the request for reconsideration of the petition under 37 CFR § 1.181, filed October 31, 2005 and supplemented by a petition filed January 12, 2006, which request the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed October 25, 2004. The original petition under 37 CFR § 1.181, filed April 8, 2005 (supplemented on June 14 & 17, 2005) was Granted-in-part in a decision mailed on September 9 and re-issued under a corrected signature on November 8, 2005.

The petition is **DENIED**.

RECENT PROSECUTION HISTORY

- (1) On October 25, 2004, a Final Office action, treating all pending claims, was mailed.
- (2) On January 25, 2005, a response was filed including: an amendment after Final rejection under 37 CFR 1.116; I.D.S.; as well as a request for reconsideration and request to withdraw the Finality of the October 25, 2004 Office action.
- (3) On February 14, 2005, an Advisory Action was mailed, indicating that the proposed amendment(s) would not be entered as they raised new issues that would require further consideration and/or search.
- (4) On April 8, 2005, a Petition under 37 CFR 1.181 requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the Final Office action mailed October 25, 2004, to enter the amendment under 37 C.F.R. 1.116 and to consider the reference(s) cited on form 1449 was filed.
- (5) On April 14, 2005, a response, exhibit, an amendment, a three month extension of time, and copy of IDS (previously filed) was filed.

- (6) On April 18, 2005, a request to withdraw the Finality, duplicate copy of response and amendment, and IDS was filed.
- (7) On April 28, 2005, a Notice of Appeal, response and (apparently different) amendment under 37 CFR 1.116 were filed.
- (8) On June 7, 2005, an Advisory Action treating proposed amendments filed April 14, 18 & 28, 2005 was mailed, indicating that the proposed amendment(s) would not be entered as they raise new issues that would require further consideration and/or search. The Advisory Action also recognized that the submission of April 8, 2005 was in fact a petition to withdraw the finality of the action mailed October 25, 2004, and forwarded such submission to the appropriate deciding officials.
- (9) On June 14, 2005, in response to the Advisory Action, a supplemental petition (to the original petition filed April 8, 2005) was filed.
- (10) On June 17, 2005, an additional supplemental petition was filed.
- (11) On September 9, 2005, a decision granting-in-part the Petition(s) filed April 8, 2005 (supplemented on June 14 & 17, 2005) was mailed. This decision was re-issued under a corrected signature on November 8, 2005.
- (12) On October 31, 2005, the instant petition under 37 CFR 1.181 was filed, which is being treated as a request for reconsideration of the decision mailed on September 9 and November 8, 2005.
- (13) On November 28, 2005, Applicant filed a petition for extension of time under 1.136(a) and 1.136(b) and a response designated as an Appeal Brief with direction that if prosecution is reopened (i.e., finality of the previous action is withdrawn) it be treated as a response to the latest Office action.
- (14) On January 12, 2006, a supplemental petition (to the October 31, 2005 petition) under 37 CFR 1.181 was filed.

RELIEF REQUESTED

The instant petitions filed under 37 CFR 1.181 request the following relief: A) withdrawal of the finality of the October 25, 2004 office action as prosecution was alleged to have been prematurely closed; and B) entry of the amendment filed April 14, 2005 under 37 CFR 1.116 (duplicate copy filed April 18, 2005).

BASIS OF THE OPINION

The guidelines for petition practice are set forth in 37 CFR §1.181 "Petitions to the Commissioner." While MPEP § 1201 outlines the differences in appealable and petitionable matters. MPEP § 1201 states in part:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

37 C.F.R. § 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

...
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

...

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom.

Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

- (1) Holding certain facts to have been established;
- (2) Returning papers;
- (3) Precluding a party from filing a paper, or presenting or contesting an issue;
- (4) Imposing a monetary sanction;
- (5) Requiring a terminal disclaimer for the period of the delay; or
- (6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

ANALYSIS

A. Petition of October 31, 2005

Applicant's arguments will be addressed in the order they are presented in the October 31, 2005 petition using Petitioner's headings to ease correlation of the responses to petitioner's arguments. The adoption of petitioner's headings is merely a bookkeeping convenience and not a concession of agreement with the positions they espouse.

I. Summary of Interview with T.C. Director Harvey

This section is applicant's version of the October 31, 2005 telephone conversation with Director Harvey. This section of the submission presents no independent arguments for review and ordinarily would occasion no response.

However, Mr. Boundy's intemperate remarks and inappropriate characterizations of the Examiner's actions compel the Office to remind the practitioner of the proper way to conduct business with the Office.

37 C.F.R. § 1.3 Business to be conducted with decorum and courtesy.

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

Practitioner should restrict his submissions to facts – not characterization of the Examiner's actions. Note that any complaints must be made in separate papers. Any future papers that violate this rule will not be entered.

II. Definition of the Legal Term of Art “New Ground of Rejection”

Petitioner cites to case law to support the position that the Examiner has raised a new ground of rejection in the final Office action.

Contrary to Petitioner's remarks, the previous decision of November 8, 2005 (herein the previous decision) did not disregard citations of case law, but rather, the examination process as well as the petition decision process utilize case law as a guideline, much like the MPEP is used as a guideline in these processes. A definition of “new grounds of rejection” which can be applied in each and every instance has *not* been directly set forth in the aforementioned guidelines but rather is determined on a case-by-case basis upon an analysis of the facts before the deciding official.

A review of the cases addressing the issue of what constitutes a new ground of rejection reveals that the determination is fact-specific and must be made on a case-by-case basis. The case law supports the position that the underlying issue is whether the Applicant was afforded a fair opportunity to respond to the rejection. If that is not the case, then the new line of reasoning or explanation constitute a new ground of rejection. “The real question is whether the new argument is such as to raise a new issue.”¹

In particular, in *Kronig*, (cited by petitioner), the BPAI's reasons for upholding the Examiner used a subset of the art relied upon in the Examiner's rejection. Nevertheless, the CCPA concluded that the Board decision did not constitute new grounds of rejection because “the basic thrust at the examiner and the board level was the same”².

Petitioner's reliance on *Kumar* is misplaced. In *Kumar*, the Board engaged in a calculation to derive a particle distribution and then use the calculated values in the decision. As there was no previous indication in the record that such a calculation was even implicitly being relied upon, it was appropriate to allow applicant an opportunity to respond.

Finally, a question whether the examiner's rejection is clear as to claim scope or what is the proper scope of a claim is directed to the sufficiency of the examiner's prima facie case and is therefore a matter for review on appeal and not subject to review by petition.

III. The Facts are Not in Dispute...

As pointed out in the previous decision, the final rejection merely elaborated on the rejection of record in response to Applicant's arguments. This did not change the thrust of the rejection and as such is not deemed to constitute new grounds of rejection.

¹ *in re Osweiler*, 145 USPQ 691 (CCPA, 1965)

² *in re Kronig*, 190 USPQ 425 (CCPA, 1976)

IV. Both Office Actions are too Incomplete to Support Final Rejection

In regard to petitioners' other arguments, the petitioners repeatedly set forth a case as to why the examiner has not met his burden of proof of setting forth a *prima facie* case for rejecting the claims over the applied prior art; the examiner's interpretation of claim limitations; the state of the art and the definitions of terms of art. These are deemed to be appealable matters and therefore are not petitionable to the Commissioner of Patents and Trademarks.

V. The Status of Claim 22 is too Unclear to Permit Appeal or Closure of Prosecution...

With respect to the comments found on pages 7-12 of the instant petition regarding the status of (currently rejected) claim 22, these arguments have been addressed in the previous decision on pages 4-5 thereof. In addition, Applicant's attention is directed to Non-Final Office action (February 11, 2004) at pages 10 & 12, paragraphs 46 & 52, and the Final Office action (October 25, 2004) at pages 2-5 and paragraphs 11-14.7 for the statement of grounds of rejection, Examiner's discussion, reasons for rejection and treatment of Applicant's arguments for claim 22 in those actions.

VI. The 9/9/05 Decision Erred by Failing to Decide an Issue Presented Relative to Claim 104

With respect to Applicant's comments found beginning in the middle of page 12 of the instant petition regarding the status of claim 104, these arguments have been previously addressed in the previous decision on pages 4-5 thereof. In addition, Applicant's attention is directed to the Non-Final Office action at pages 2 and 9, paragraphs 10 & 42, and the Final Office action at pages 2 - 5, paragraphs 10 and 14-14.7 for the supporting statement of grounds of rejection, Examiner's discussion, reasons for rejection and treatment of Applicant's arguments for claim 104 in those actions. Further, and contrary to the remarks bridging pages 12-13 of the instant petition, the mere inclusion of a "typographical error" in the Final Office action and as identified to Applicant in the Advisory Action of February 14, 2005 (see paragraph 3 thereof), does not render the Final rejection incomplete and unclear. Such identification of a typo does however, afford Applicant the ability to present a clear and complete Appeal Brief as such issues of complete and clear establishment of claim scope as well as decisions on establishment of Prima Facie obviousness are appealable matters, rather than petitionable ones, and are best resolved by the Board.

VII. General Comments

Petitioner's argument throughout the instant petition as to the impropriety of the Final Rejection is predicated not on a change of position, but on an assertion of the incompleteness of the original Office action. A petition regarding the completeness of an action is considered to be timely if filed within two months of the action complained of. Here, Applicant chose to continue prosecution by filing a response (including an amendment and remarks) and did not petition for correction of what Applicant now identifies as deficiencies in the first Office action. Applicant cannot avoid finality by raising issues with respect to the first Office action at this stage of the proceedings.

Further, comments with respect to internal Office procedures (i.e. crediting of work completed) are neither petitionable nor appealable matters and will not be addressed further in this decision.

B. Petition of January 12, 2006

I. Petitioner presents no new arguments in this petition, merely restatements of those previously presented. Therefore, all arguments have been treated. In addition, new arguments presented at this late date are untimely and are not entitled to consideration.

II. Representations regarding statements of Office Personnel

Petitioner attributes various comments and statements to Office personnel which are inaccurate and misleading. These statements may be caused by lack of care on applicant's part. An example of one of the misstatements made in the record of the instant application on Petitioner's part appears in the summary of the telephone interview of October 30, 2005, on page 3 of the January 12, 2006 petition, wherein Petitioner indicates that "It was agreed that the Decision of 9/9/05 was withdrawn, and a new decision would be issued."

The undersigned's recollection of the conversation of October 30, 2005 was that Applicant was informed that the decision (signed by SPRE Johnson) would be remailed under Director's own signature after having been reviewed prior to its remailing.

However, a review of Petitioner's *own* transcript of the telephone conversation (see transcript, pages 2-3, in comments filed December 1, 2005) of October 30, 2005 shows in fact, Director Harvey indicated "I have to issue this petition again and I will have to sign it" and "We are going to remail out this [decision]". At no point in the conversation does Director Harvey indicate that the decision was withdrawn nor that a new decision will be rendered.

Although Applicant is appropriately vigorously advocating on behalf of his client, care should be taken to ensure that all statements made are supported by the facts of record. Applicant is cautioned that submissions are governed by 37 C.F.R. § 10.18 which provides for severe consequences for false statements.

DECISION

Therefore, as stated in the previous decision and re-affirmed herein, the Examiner's holding of Finality with respect to the rejections of record in the Final Office action mailed October 25, 2004 is correct and in accordance with Office policy and practice. Accordingly the petition to withdraw the finality is **DENIED**.

The propriety of the Examiner's refusal to enter the amendment after final will now be addressed.

In the response filed April 14, 2005, Applicant indicates that since the finality of the Office action of October 25, 2004 was premature, that "the amendments proposed here may be entered

as a matter of right. Even if finality is maintained, these amendments are entitled to entry under Rule 116”.

The relevant section of the MPEP concerning entry of amendments after final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection.

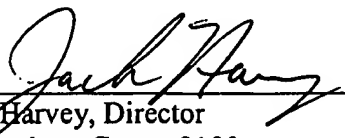
The propriety of the Examiner’s refusal to enter the proposed after final amendment were fully addressed in the previous decision. For the reasons stated therein and above, the Examiner’s refusal to enter the proposed amendment filed after final rejection is correct and consistent with Office policy and practice. Accordingly, the petition to compel the examiner to enter the amendment is **DENIED**.

CONCLUSION

For the above stated reasons, the petition to withdraw the finality of the final Office action of October 25, 2004 is **DENIED**.

For the above stated reasons, the petition to enter the amendment filed after final rejection under 37 CFR §1.116 is **DENIED**.

The response, remarks, summary of interview on October 30, 2005, petition for extension of time and Appeal Brief, filed December 1, 2005 are acknowledged. The application will be forwarded to the Examiner of record for consideration and action on the merits thereof. The request for the five months extension of time for filing the response, remarks, interview summary and Appeal Brief are noted. The fee for a five-month extension of time, which was necessary to preserve pendency, was charged on December 7, 2005 as authorized by petitioner.


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